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EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,172

Applicant(s)

SWIERCZEK, REMI

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-13, 15 and 17-20 are pending in the instant application. Claims 1-2, 10-13, 15 and 17-18 have been amended, claims 14 and 16 have been cancelled, and claim 20 has been added via Paper No. 10.

Drawings

The substitute drawings were received on 15 May 2003. The Examiner accepts these drawings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 10-13, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pocock U.S. Patent No. 6,314,577.

Referring to claims 1 and 10. Pocock discloses a method for purchasing a recorded music item (at least column 1, lines 9-27, "The present invention relates generally to a method and apparatus to enable a broadcast listener to automatically purchase a music product such as a record album, cassette tape or compact disk...") comprising the following steps:

- a) Providing a recording device;
- b) Recording data related to a music item playing on a radio (at least column 1, lines 9-27, "...a digitally stored audio database containing the names of

musical artists and groups, the names of pieces which have been recorded on the musical products, musical excerpts of these pieces, and a telephone system to replay this descriptive information through a telephone connection to a potential purchaser”);

- c) Transmitting said data from said recording device to a music identification/purchasing system (at least column 1, lines 9-27, “The present invention relates generally to a method and apparatus to enable a broadcast listener to automatically purchase a music product such as a record album, cassette tape or compact disk...”);
- d) Receiving purchasing information from said music identification/purchasing system related to said music item (at least column 4, lines 34-48, “These audio segments can be accessed by the potential purchaser to assist in the purchase process and to verify to the caller they are purchasing the music product containing the music piece listened to during the radio broadcast.”);
- e) Transmitting at least one music item selection and payment information to said music identification/purchasing system (at least column 3, lines 3-11, “When the potential purchaser indicates they are ready to order, the automated order system obtains the correct name and shipping address by accessing a name and address database responsive to the consumers telephone number or credit card information. The system also records the consumer’s credit card information and obtains credit authorization. The

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invention then transmits the complete order to the fulfillment warehouse for shipment of the musical product to the purchaser."); and

- f) Receiving said at least one music item selection (at least column 5, lines 21-24, "When the potential purchaser indicates they wish to buy a particular music product the system determines the shipping address and credit authorization and then places the order for the music product with the fulfillment warehouse.").

Pocock does not expressly disclose a portable recording device. Making something portable does not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See Ranco, Inc. v. Gwynn et al., 128 F.2d 437 [54 USPQ 3]. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to make the user device disclosed in Pocock portable in order to provide the user with a timely method to purchase a musical product (Pocock: at least column 2, lines 36-45).

Referring to claim 2. Pocock further discloses a method for purchasing a recorded music item comprising the step of identifying said music item by comparing the time said music item was recorded with a play list from a designated music station (at least column 3, line 57 to column 4, line 11).

Referring to claim 3. Pocock further discloses a method for purchasing a recorded music item wherein said data includes at least a time, a date, and either a

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station frequency and a location of said station or a four letter station identification code (at least column 3, line 39 to column 4, line 33).

Referring to claim 5. Pocock further discloses a method for purchasing a recorded music item wherein said data is transmitted to said music identification/purchasing system by means of a telephone (at least Fig. 6).

Referring to claim 11. Pocock further discloses a method for purchasing a music item further comprising the step of identifying said segment of music item playing on the radio (at least column 3, line 39 to column 4, line 33).

Referring to claim 12. Pocock further discloses a method for purchasing a recorded music item wherein said step of identifying said segment of music comprises the following steps:

- a) Entering said transmitted segment of music into a central processing unit (at least at least column 2, lines 37-45);
- b) Analyzing and comparing said transmitted segment of music to music contained in a database (at least column 2, lines 37-45); and
- c) Identifying a music selection providing the closest match to said transmitted segment of music (at least column 3, line 57 to column 4, line 11).

Referring to claim 13. Pocock discloses a process of identifying music (at least column 1, lines 9-27, "The present invention relates generally to a method and apparatus to enable a broadcast listener to automatically purchase a music product such as a record album, cassette tape or compact disk...") comprising:

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- a) Providing a communication device;
- b) Recording a segment of music playing on a radio using said communication device;
- c) Transmitting said recorded musical segment from said communication device into a central processing unit (at least column 2, lines 37-45, "It is therefore an object of this invention to provide an automated transaction system to record and track radio audio segments enabling a radio listener to use their telephone to recall and preview, on-demand, music pieces previously broadcasted...");
- d) Analyzing and comparing said musical segment to a database of musical works (at least column 2, lines 37-45);
- e) Identifying at least one closest match (at least column 3, line 57 to column 4, line 11); and
- f) Generating database information regarding said at least one closest match (at least column 3, line 57 to column 4, line 11).

Pocock does not expressly disclose a portable recording device. Making something portable does not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See Ranco, Inc. v. Gwynn et al., 128 F.2d 437 [54 USPQ 3]. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to make the user device disclosed in Pocock portable in order to provide

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the user with a timely method to purchase a musical product (Pocock: at least column 2, lines 36-45).

Referring to claim 15. Pocock discloses a music identification/purchasing system (at least column 1, lines 9-27, "The present invention relates generally to a method and apparatus to enable a broadcast listener to automatically purchase a music product such as a record album, cassette tape or compact disk...") comprising:

- a) A means for receiving an audio playback of a selected musical work from a communications device (at least column 1, lines 9-27);
- b) A means for storing information related to a plurality of musical works (at least Figure 7, "Database 7014");
- c) A means for identifying said selected musical work from said means for storing information related to the plurality of musical works based on said received audio playback (at least column 1, lines 9-27);
- d) A means for providing information related to said selected musical work (at least Abstract); and
- e) A means for purchasing said selected musical work or an item related to said selected musical work (at least column 3, lines 3-11).

Pocock does not expressly disclose a portable recording device. Making something portable does not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See Ranco, Inc. v. Gwynn et al., 128 F.2d 437 [54 USPQ 3]. At the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art to make the user device disclosed in Pocock portable in order to provide the user with a timely method to purchase a musical product (Pocock: at least column 2, lines 36-45).

Referring to claim 17. Pocock further discloses a music identification/purchasing system wherein said means for identifying said selected musical work from said means for storing information related to the plurality of musical works based on said received audio playback comprises a central processing unit accessing a database containing information related to the plurality of musical works (at least Figure 7 and column 2, line 27 to column 3, line 2).

Referring to claim 18. Pocock further discloses a music identification/purchasing system wherein said means for receiving an audio playback of a selected musical work from a portable communications device comprises a user interface including a microphone (at least Figure 7 and claim 74).

Referring to claim 19. Pocock further discloses a music identification/purchasing system wherein said means for purchasing comprises an ordering system including price, availability, shipping method, and payment options (at least column 3, lines 3-11, "When the potential purchaser indicates they are ready to order, the automated order system obtains the correct name and shipping address by accessing a name and address database responsive to the consumers telephone number or credit card information. The system also records the consumer's credit card information and obtains credit authorization. The invention then transmits the complete order to the fulfillment warehouse for shipment of the musical product to the purchaser.").

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Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claims 12 and 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pocock U.S. Patent No. 6,314,577 in view of Official Notice.

Referring to claims 4, 6, and 8. Pocock discloses a method according to claim 1 as indicated supra. Pocock further discloses a method for purchasing a recorded music item:

- Wherein said data is transmitted to said music identification/purchasing system by means of a communications interface (at least claim 32);
- Wherein said purchasing information is received by means of a communications interface (at least claim 32); and
- Wherein said step of receiving said at least one music item selection is accomplished over a communications interface (at least claim 32).

Pocock does not expressly disclose a method for purchasing a recorded music item utilizing the Internet. Examiner takes Official Notice that utilizing the Internet does not act to Patentability distinguish the immediate invention. In determining the obviousness of applying what is generally known in the music industry to what is known

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in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to transmit information. The desirability to do this is clearly to establish a direct marketing operation enabling the linking of radio stations into a common national market (Pocock: at least column 1, line 30 to column 2, line 24).

Referring to claims 7 and 9. Pocock discloses a method according to claim 1 as indicated supra. Pocock further discloses a method for purchasing a recorded music item:

- Wherein said purchasing information is received by a communications interface (at least claim 32); and
- Wherein said step of receiving said at least one music item selection is accomplished by a communications interface (at least claim 32).

Pocock does not expressly disclose a method for purchasing a recorded music item utilizing mail. Examiner takes Official Notice that utilizing mail does not act to Patentability distinguish the immediate invention. In determining the obviousness of applying what is generally known in the music industry to what is known in the world of mail one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The mail, to one ordinarily skilled in the art, for some time now is

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recognized as a vehicle in which information is shared from location to location. A typical example would be for one individual to access and receive files from another individual located at a different location than the first. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the mail to transmit information. The desirability to do this is clearly to establish a direct marketing operation enabling the linking of radio stations into a common national market (Pocock: at least column 1, line 30 to column 2, line 24).

Response to Arguments

Applicant's arguments with respect to claim 1-3, 5, 10-13, 15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

The Attorney argues that Pocock does not expressly disclose a portable recording device. The Examiner notes that making something portable does not render the claims patentable since it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. See Ranco, Inc. v. Gwynn et al., 128 F.2d 437 [54 USPQ 3]. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to make the user device disclosed in Pocock portable in order to provide the user with a timely method to purchase a musical product (Pocock: at least column 2, lines 36-45).

The Attorney argues that Pocock does not involve the step of recording data related to the music item playing on the radio. The Examiner notes that Pocock does provide an automated transaction system to record and track radio audio segments enabling a radio listener to use their telephone to recall and preview, on-demand, music

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pieces previously broadcast thereby assisting the listener in the purchase of a music product such as a record album, cassette or CD. The invention provides the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase (at least column 2, lines 36-45).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

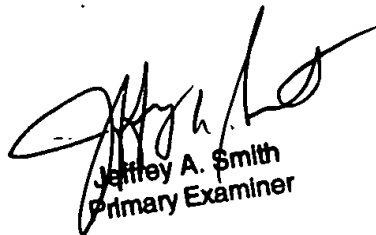
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

May 19, 2003


Jeffrey A. Smith
Primary Examiner